

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

Expedited Handling
Response under 37 CFR 1.116

Appln. Ser. No.:	Filed:	Inventor(s):	Atty Dkt:
09/074,012	5 May 1998	S. YOSHIDA <i>et al.</i>	114GI-121 (0694-121)
Title: High Thermal Conductivity Composite Magnetic Body			
Examiner: B. Pianalto		Art Unit: 1762	

Asst. Comm'r for Patents
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Washington, D.C. 20231-0001

RESPONSE AFTER FINAL REJECTION
and Petition for Extension of Time

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Dear Sir:

In complete response to the Office Action mailed 7 January 2002 in which the rejections were designated as final, the period for response being extended one month to 7 May 2002 by the Petition at the end of this paper, reconsideration of the subject application is respectfully requested.

In that Office Action, the response to Applicants' arguments that claim 10 recites two separate powders, a soft magnetic powder and a heat conductive powder, was that "[t]he examiner is not convinced by this argument since nowhere in the four corners of applicants' claim 10 can 'separate' be found. The particles of applicants' claim 10 encompass a single particle having both properties."

The language of claim 10 is that the article is "comprised of soft magnetic powder dispersed through an organic binding agent and also including a heat conductive powder dispersed therethrough." If it were the same powder that were

both soft magnetic and heat conductive, one would have expected the claim to recite "and also being" a heat conductive powder instead of "and also including" a heat conductive powder. The plain language of the claim requires that there be two powders.

If the Examiner's point is that there is no support for separate powders, it should be noted that dependent claim 11 recites that the "heat conductive powder" of claim 10 is Al_2O_3 , AlN, BN, or SiC. As none of these materials is a soft magnetic material, (i) there is support for a non-magnetic heat conducting powder and (ii) it would seem that the Examiner would have alleged that this claim 11 is not supported. Claim 11 does not recite the article as "further comprising" but instead merely specifies "wherein said heat conductive powder" as being one of those mentioned above. Accordingly, it must be the case that claim 10 recites two separate powders, one being soft magnetic and the other being heat conducting.

If it is the Examiner's point that there is no written description of separate soft magnetic and heat conductive powders, reference is made to the original claims 1 and 2, which parallel present claims 10 and 11, and so the foregoing arguments are reiterated.

Claim 15 was not addressed in the Office Action of 7 January, yet it recites "a first soft magnetic powder and a first heat conductive powder." Again, the plain language of this claim is that there are two separate powders.

The present case is unlike the *Van Geuns* case cited in the communication, because there the inventor had argued the uniformity of the recited magnet for use in NMR and MRI, which uniformity was not recited in the claims. The present situation is a question of interpreting the plain language of the claim without reference to the specification: for claim 10, whether the phrase "and also

including" in the recitation means an additional powder or another property of the powder.

That the soft magnetic powder may also be a heat conductive powder does not change the meaning of the claim language requiring the presence of two powders.

It is not believed that the Office has made out a legally sufficient rationale in support of this obviousness rejection. *Ex parte Jones*, 62 U.S.P.Q. 1206, 1207 (BPAI 2002). Accordingly, the rejection should be withdrawn.

Please note that this application has been transferred to the undersigned, even though a new power of attorney has yet to be filed. Should the Examiner wish to discuss this application, please phone the undersigned at the number shown below.

Petition for Extension of Time

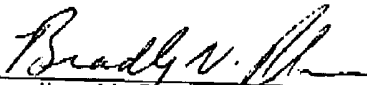
Pursuant to the provisions of 37 CFR 1.136(a), Applicants hereby petition for a one month extension of time to 7 May 2002 in order to respond to the Office Action dated 7 January 2002. Please debit Deposit Account 502144 for the extension fee and any fees under 37 C.F.R. § 1.16 or § 1.17 necessitated by this filing.

**CERTIFICATE OF MAILING OR
TRANSMISSION - 37 CFR 1.8**

I hereby certify that I have a reasonable basis that this paper, along with any referred to above, (i) are being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231, or (ii) are being transmitted to the U.S. Patent & Trademark Office in accordance with 37 CFR § 1.6(d).

DATE: 7 May 2002
NAME: BRAD RUBEN
SIGNATURE: Brad Ruben

Respectfully submitted,


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7 May 2002